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09/497,123	02/03/2000	Dominique D. Messerli	8932-114	7121

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EXAMINER

PELLEGRINO, BRIAN E

ART UNIT	PAPER NUMBER
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3738

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Paper No. 16

Application Number: 09/497,123

Filing Date: 02/03/00

Appellant(s): Messerli et al.

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Brian Malm

For Appellant

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**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 7/26/02.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

**(3) *Status of Claims***

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

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Claims 18 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 22 and 23 have been canceled.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: 1) the rejections on appeal of claims 1,2,17 and 18 as being unpatentable under U.S.C. 103a over Kuslich '291 in view of Paul '033 and claim 19 as obvious in view of Kuslich '291 in view of Paul '033 and Camino '613 have been withdrawn in view of the applicant's statement that the subject matter was commonly owned at the time the invention was made.

**(7) *Grouping of Claims***

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because the appellant has failed to present reasons why certain claims stand alone.

**NOTIFICATION OF NON-COMPLIANCE WITH THE REQUIREMENTS OF 37 CFR 1.192©**

The brief includes a statement that claims 2 and 18 do not stand or fall together, but fails to present reasons in support thereof as required under 37 CFR 1.192(c)(7). MPEP § 1206.

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**(8) Claims Appealed**

The copy of the appealed claims contained in Appendix B to the brief is correct.

**(9) Prior Art of Record**

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,702,451	Biedermann et al.	12-1997
5,776,197	Rabbe et al.	7-1998

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1,7,9,14,15,17 are rejected under 35 U.S.C. 102(b) as being anticipated by Biedermann et al. '451. Fig. 3 shows an end member with a top surface "adopted and configured to engage bone" since it has holes for tissue ingrowth and permits bone to be pushed into it. Fig. 6 illustrates the end member having a flat planar surface and has two sections that can be construed as the first and second portions (12, 19). Since claims are to be interpreted in light of the specification, which includes drawings (note: applicant's drawings show the shoulder integral with the first portion) claims are interpreted that the shoulder is integral with the first portion. It can also be construed that the shoulder is the part that supports teeth 15 and is sized to rest on and edge of the implant, Figs. 6,8,10 show how the elements protrude outward beyond the second portion and will rest in recesses 9,10 shown in implant of Fig. 1. Claims in a pending application should be given their broadest reasonable interpretation. In re Hyatt, 54 USPQ2d 1664 (Fed. Cir. 2000). In this instance it can be interpreted that Fig. 7 shows a first channel extending from the edge, such that it is formed between the teeth 15 that protrude outward from the edge and has a second channel such that they run anterolaterally. Additionally, a surgical instrument that grabs or clamps is fully capable of being received in the channels.

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Fig. 7 shows the top surface is oval. Regarding claim 17, it can be seen in Figs. 8 and 10, that the second portion has a plurality of tabs **21'**.

Claims 1,2,9,14 are rejected under 35 U.S.C. 102(e) as being anticipated by Rabbe et al. '197.

Fig. 3 shows an end member **22** for a bone implant having a first portion **35** and second portion **37**. Since claims are to be interpreted in light of the specification, which includes drawings (note: applicant's drawings show the shoulder integral with the first portion) they are being interpreted according to what applicant discloses, a shoulder that is integral with the first portion. The shoulder portion is fully capable of being sized to rest on a corresponding edge of a properly dimensioned implant. It can be seen the top surface is a flat planar surface and has a first and second channels **47** extending from the edge that are fully capable of receiving an instrument. Additionally, it can be seen the top surface has a plurality of teeth **120** in a two dimensional array that extend from apertures **46** about the top surface, see also Fig. 7.

**(11) Response to Argument**

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., channel in the top surface) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In this instance, Biedermann has channels extending from the edge as claimed and as stated above in the rejection are spaces between two teeth **15** that extend from the edge.

In response to applicant's argument that Rabbe is not sized to rest on an edge of the implant, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior

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art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Please note that applicant is claiming an **end member** and not the *combination* of the end member and implant. Thus applicant's limitation of resting on an edge does not warrant much weight because it is conditional, i.e. "when the second portion is inserted in the bore of the implant." Since the applicant is not positively claiming the *implant* and has no structure to define it, Rabbe is sized to rest on an edge of a properly dimensioned implant. Regarding the channels, Rabbe clearly has channels extending from the edge and are fully capable of receiving a surgical instrument. Regarding appellant's remarks about the teeth, as best understood, in light of the elected species (Fig. 9) the Rabbe teeth are clearly a two dimensional array.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Brian Pellegrino


October 29, 2002

TC 3700, AU 3738


Conferees

Bruce Snow

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